

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-5 and 7-22 remain in the application. Claims 5 and 7-11 are subject to examination and claims 1-4 and 12-22 have been withdrawn from examination. Claims 6, and 23-24 have been previously canceled.

In item 4 on page 3 of the above-identified Office Action, claims 5 and 7-11 have been rejected as being unpatentable over Montgomery et al. (U.S. 5,947,028) (hereinafter "Montgomery") in view of Leanna et al. (U.S. 4,116,594) (hereinafter "Leanna") and Lindner et al. (U.S. 5,479,859) (hereinafter "Lindner") under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their previous form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 5 calls for, *inter alia*, an imaging assembly, having a printing plate, and an imaging machine for setting an image on the printing plate, the printing plate formed of a

magnetically attractable material, the imaging machine including a magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets, the magnetic cylinder having a register system aligning the printing plate, and the printing plate having an edge, the substantially U-shaped register cut-outs being disposed in the edge. (emphasis added)

Montgomery discloses printing, printing plates, and drums therefor (see col. 1, lines 5 et seq.). In particular, Montgomery discloses apparatus for holding metal printing plates on a rotating drum by the use of a vacuum. Holding the plates in place on the drum is facilitated by bending at least one edge of the plate to approximately match the drum curvature. Montgomery does not disclose or suggest substantially U-shaped cut-outs for aligning the printing plate accurately in position relative to the magnetic cylinder, before it is firmly clamped in place, according to the present claimed invention. Montgomery is silent on and does not disclose the use of magnets. The Examiner acknowledges that **Montgomery is silent and therefore deficient** with respect to at least two primary claimed features of claim

5, namely, "the particular details of the magnetic drum and whether the magnetic material in the cylinder includes one of a permanent magnet and electromagnet" and "whether the drum includes a register system for aligning the printing plate with U-shaped register cut-outs."

The Examiner also acknowledges that a combination of Montgomery and Leanna "fail to teach a printing plate including a plurality of U-shaped register cut-outs provided in one edge of the printing plate" as set forth in claim 5.

To make up for this prior art deficiency, the Examiner with hindsight reaches into the prior art and locates the Lindner reference, in an unsuccessful attempt to arrive at the claimed invention.

Thus, on each occasion the Examiner recognizes that the prior art is deficient with respect to a claimed feature, which in this instance amounts to three claimed features absent from the prior art, the Examiner seeks to find the missing feature in a secondary prior art reference.

It is respectfully submitted that such a reconstruction and conglomeration of prior art references is improper and not in accordance with proper U.S. Patent practice, notwithstanding

the Examiner's unsuccessful attempt to disregard and refute applicants' arguments for patentability of the present claimed invention.

Contrary to Montgomery, Leanna discloses embossing, embossing plates, and embossing rollers therefor. Leanna discloses an embossing apparatus for applying a continuous pattern to webs of material such as paper and a method for producing an embossing surface. Further, in sharp contrast to the present claimed invention, Fig. 15 of Leanna shows that the two register cut-outs 56" are located in two different plate edges or locations (not in one and the same plate edge as recited in claim 5). In other words, the two plate edges or locations in Leanna are each provided with a single register cut-out 56 (not with a plurality of register cut-outs as recited in claim 5).

Applicants submit that the Examiner's assumption that printing and embossing are, by their nature, identical processes and therefore interchangeable is incorrect, notwithstanding the Examiner's statements in the above-identified Office Action. The combination of Montgomery and Leanna is based purely on hindsight reconstruction of the prior art in view of applicants' disclosure. One skilled in the art would not consider combining the references, because the printing of

Montgomery and embossing of Leanna are completely different processes by their very nature and completely different equipment is required for the respective processes.

Furthermore, Leanna actually teaches away from combining Leanna with Montgomery. **Leanna specifically acknowledges that "printing and embossing differ both as regards equipment employed and the nature of the process"** (see col. 2, lines 5-8), which is contrary to the Examiner's assertions that they are analagous and further supports applicants' arguments.

The Examiner's acknowledgements that Montgomery is **silent** with respect to the aforementioned claimed features of the present invention further supports applicants' argument that there is no reason to arbitrarily take from Leanna the features of a "magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets" and "the magnetic cylinder having a register system aligning the printing plate, and the printing plate having substantially U-shaped register cut-outs cooperating with the register system register system" and arbitrarily add them to Montgomery as proposed by the Examiner, **but for** applicants' disclosure. Therefore, it is submitted that the proposed combination of

references is improper. Further, even if the references were combinable, the resulting structure still would not meet the claim limitations, in particular because Leanna does not disclose "...substantially U-shaped register cut-outs being disposed in" one and the same edge of the printing plate as recited in independent claim 5 as acknowledged by the Examiner's statement that "Montgomery et al. in view of Leanna et al. fail to disclose" this specifically claimed feature.

The Examiner attempts to overcome this important deficiency in the prior art by using the secondary Lindner reference to modify the combination of Montgomery and Leanna. Lindner discloses a method and apparatus for controlling an automated printing plate changing process. A used printing plate is removed from the gripping portion 22 of a clamping rail 20 and a new printing plate is guided into the opened gripping portion. Sensors determine whether the used plate has been removed and the new plate is properly loaded. The front edge 12 of the printing plate has notches 24, 25, which align with register pins 30A, 30B to help align the printing plate

The Examiner alleges that it would be obvious to one skilled in the art to insert two register cut-outs into one and the same plate edge of the plate (shown by notches 24, 25 in Fig. 2 of Lindner), instead of one register cut-out disclosed by

Leanna. In other words, the Examiner alleges, and wrongfully so, that it would be feasible to replace the single register cut-out "56" in Leanna with the two register cut-outs 24, 25 from Lindner because this would "insure the entire edge of the plate is in proper register on the cylinder...to provide high quality printing." The Examiner has not shown a sufficient reason in the combination of Montgomery and Leanna for such a substitution or modification other than the Examiner's own opinion and desire to show the claimed invention. The combination of Leanna and Lindner proposed by the Examiner would likely result in a printing plate having three register cut-outs in total, i.e., in the front plate edge the two register cut-outs 24, 25 taught by Lindner, and in the rear plate edge the register cut-out 56 shown by Leanna. Because the combination of Leanna and Lindner would have three register cut-outs in total and register pins engaging those cut-outs, instead of only two register cut-outs and register pins, this combination would cause problems with the dimensions of the plate. The proposed replacement of the register cut-out 56 in Leanna, which is in the front plate edge, with the two register cut-outs 24, 25 from Lindner is thus completely technically impractical and also is not obvious to one skilled in the art.

Alternatively, one could argue that the register cut-out 56" of Leanna, which is in the rear plate edge, could be eliminated to avoid dimensioning problems with the plate, so that the plate which results from the combination of Leanna and Lindner only has the two register cut-outs 24, 25 in the front plate edge. However, such an argument finds basis only in a hindsight reconstruction of the prior art in view of applicants claimed invention consideration, Leanna does not suggest or teach that the rear plate edge is positioned in a sufficiently precise manner to do without the cut-out 56". Instead, a person skilled in the art to which the present invention relates would learn from Leanna that the register cut-out 56" in the rear plate edge is essential and indispensable for precise positioning of the rear plate edge and therefore, cannot be eliminated.

The references do not show "a magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets, the magnetic cylinder having a register system aligning the printing plate, and the printing plate having an edge, said substantially U-shaped register cut-outs

being disposed in said edge" as recited in independent claim 5 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 5. Claim 5 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 5.

In view of the foregoing, reconsideration and allowance of claims 5 and 7-11 are solicited.

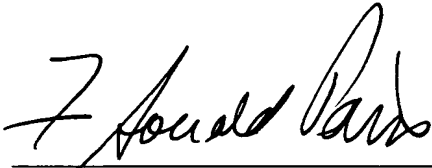
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Appl. No. 09/833,349
Amdt. Dated December 30, 2004
Reply to Office Action of November 12, 2004

Please charge any other fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "F. Donald Paris", written over a horizontal line.

F. Donald Paris (24,054)

FDP/tk

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